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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,104	03/30/2004	Robert Connolly	BHB-141	5547
22827	7590	09/21/2006		
DORITY & MANNING, P.A. POST OFFICE BOX 1449 GREENVILLE, SC 29602-1449			EXAMINER STASHICK, ANTHONY D	
			ART UNIT 3728	PAPER NUMBER

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/813,104	<b>Applicant(s)</b> CONNOLLY ET AL.	
	<b>Examiner</b> Anthony Stashick	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.  
4a) Of the above claim(s) 15-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 15-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 22, 2006. However, since the traversal did not include any arguments to support the traversal, it will be considered an election without traverse. Therefore, an office action on the merits of claims 1-14 and 24 follows and the requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 6-8 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Rauch 6,508,015. Rauch '015 discloses all the limitations as claimed including the following: an article of footwear (see Figure 7) comprising an upper and a sole, said sole comprising an outsole 2 of a first material (polyurethane, see col. 4, lines 28-36), said outsole having a periphery following the general contour of a human foot (see Figures 2 and 3), said outsole having a forefoot portion and a heel portion (see Figures 2 and 3); and at least one pod 1 of a second, different material (polyethylene, see col. 4, lines 20-22) located in at least one of said portions of said outsole (see Figures 2 and 3), said pod having a ground engaging end 4a and an upper end (that portion which contacts 10), said upper end having a flange (that portion of 1 that extends into 3 in Figure 1) proximate thereto and extending outwardly therefrom, said pod being secured in situ within said first material (see Figure 1), encapsulating said flange to form a

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ground-engaging surface generally coterminous with said ground-engaging end of said pod (see Figure 1); said pod is positioned in said forefoot portion of said outsole (see Figures 1 and 2); said pod is positioned in said heel portion of said outsole (see Figures 1 -3); said outsole is formed from polyurethane (see col. 4, lines 28-36); said flange defines a plurality of openings (6 as shown in Figure 5) and said first material extends through said openings (see Figure 5); a plurality of pods are secured within said outsole (both in forefoot and heel as seen in Figure 2); said plurality of pods are located in at least one of said portions of said outsole (see Figure 2).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 9-10 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rauch 6,508,015 as applied above in view of Friton 6,226,896. Rauch '015 as applied above discloses all the limitations substantially as claimed except for the pod being formed of rubber. Friton '896 teaches that pods 13 can be formed of layers of material such as foam 15 and rubber 17, with the rubber material (17 see col. 5, lines 13-27) on the outer engaging surface to protect the pod from wear. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the outer layer of the pods of Rauch '015 as applied above out of rubber, as taught by Friton '896 to help protect the pods from excessive wear.

6. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 9 above in view of Sessa 5,815,949. The references as applied to claim 9 above disclose all the limitations of the claims except for the ground-engaging ends/surfaces of the pods being

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textured. Sessa '949 teaches that the ground engaging ends of pods 34 can be textured to provide a non-slip surface (see col. 3, lines 39-41). Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the ground engaging ends of the pods of the references as applied to claim 9 above textured, as taught by Sessa '949, to provide the pods with a non-slip surface to prevent the user from slipping when using the shoe.

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

8. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS